

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on August 19, 2003, and the references cited therewith.

Claims 4 and 13-14 have been canceled. Claims 1, 3, 5-12, and 15-20 have been amended. New claims 21-23 have been added. As a result, claims 1-3, 5-12, and 15-23 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

#### **Amendments to the Abstract**

The Abstract has been amended to correct a typo and a punctuation error. No new matter has been introduced through these amendments to the Abstract.

#### **Amendments to the Specification**

The Examiner requested correction of a typo on page 4, line 8 of the specification.

Applicant has carefully reviewed the entire specification. In addition to the above-mentioned typo, Applicant has corrected a typo in the Abstract and has attached a clean copy of the Abstract on a separate sheet.

Also, in general, Applicant has made several amendments to the specification by substituting "embodiments of the invention" or "inventive subject matter" for "present invention"; by deleting certain instances of "invention"; by deleting the sub-title "Summary of the Invention" and corresponding text paragraphs; and by deleting the sub-title "Conclusion".

The paragraph beginning on page 1, line 6, has been amended to recite *inter alia* that the inventive subject matter relates to combining captured speech with a captured image in a digital camera to store a composite digital data file. Support for this amendment may be found, for example, on page 2, lines 1-6 of the original written description, and in original claim 8.

Also, in the paragraph beginning on page 2, line 21, the sentence "Such embodiments of the inventive subject matter may be referred to, individually and/or collectively, herein by the term "invention" merely for convenience and without intending to voluntarily limit the scope of

this application to any single invention or inventive concept if more than one is in fact disclosed.” has been inserted.

No new matter has been introduced through these amendments to the specification.

### **Amendments to Claims 1, 3, 5-12, and 15-20**

Original claims 1, 3, 5-12, and 15-20 have been amended. No new matter has been introduced.

Certain of the amendments to the claims are made to satisfy Applicant's preferences, not necessarily to satisfy any legal requirement(s) of the patent laws, and they are not intended to limit the scope of equivalents to which any claim element may be entitled.

In general, many of the claim amendments involve substituting the infinitive form of the verb for the present tense of the verb.

Substantive amendments to the claims will now be discussed.

Independent claim 1 now recites that the captured image and text are stored as a single digital data file.

Claim 3 now recites that the processor is to additionally store the text as a separate digital data file in the memory.

In claims 6 and 18, the word “comprises” has been substituted for “is”.

In claims 7, 10, and 19, the phrase “to respond to” has been inserted.

Independent claim 12 now additionally recites “storing the text data and the digital image data as a composite digital file in a memory of the camera”.

Independent claim 15 now additionally recites “combining the digital image data and the text data into a single digital data file”.

Independent claim 16 now recites “a camera having a microphone, a memory, and a photo-sensitive array to capture an image”.

Independent claim 20 now recites a method of operating a portable camera. It further recites capturing audio input as an audio file, and storing the audio file and the digital image data as separate digital data files in a memory of the camera. Support for a “portable camera” may be found, for example, on page 4, line 19 of the original written description.

### **New Claims 21-23**

New claims 21-23 have been added to provide Applicant with additional protection to which Applicant is entitled. New claims 21-23 are supported by the original disclosure. No new matter has been introduced.

New dependent claim 21 is dependent upon claim 12 and recites that the method further comprises additionally storing the text data as a separate digital file in the memory. Support may be found, for example, on page 3, line 30 of the original written description.

New dependent claim 22 is dependent upon claim 15 and recites that the method further comprises additionally storing the text data as a separate digital data file in the memory. Again, support may be found, for example, on page 3, line 30 of the original written description.

New dependent claim 23 is dependent upon claim 20 and recites that the audio file is stored as a compressed audio file in the memory. Support may be found, for example, on page 4, line 8 of the original written description, and in FIG. 3 (block 208).

### **Rejection of Claims 1-4, 8 and 11 under 35 U.S.C. §102(b) as Anticipated by Ishii**

Claims 1-4, 8 and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii (U.S. 4,742,369).

Ishii discloses an electronic still camera that enables an image to be previewed on a digital display before being committed to storage on film (refer to Abstract). Ishii also discloses that "a voice input through a microphone 151 is . . . supplied to and recognized by voice recognition circuit 155, and is written in image memory 156" (see col. 14, lines 60-65; refer to FIG. 24). However, it is noted that Ishii does not disclose combining a text file and an image file into a single digital data file in the memory.

The rule under 35 U.S.C. §102 is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Ishii does not disclose all of the structural elements recited in claim 1, as amended. For example, Ishii fails to disclose storing the captured image and the text as a single digital data file in the memory. )

For the above reasons, claim 1 should be found to be allowable over Ishii, and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(b) as anticipated by Ishii be withdrawn.

Claims 2-3, which depend from claim 1 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Claim 4 has been canceled, as mentioned earlier.

Regarding independent claim 8, as amended, Ishii does not disclose all of the structural elements recited. For example, Ishii fails to disclose storing the digital image file and the digital text file as a single composite digital data file in the memory.

For the above reasons, claim 8 should be found to be allowable over Ishii, and Applicant respectfully requests that the rejection of claim 8 under 35 U.S.C. §102(b) as anticipated by Ishii be withdrawn.

Claim 11, which depends from claim 8 and incorporates all of the limitations therein, is also asserted to be allowable for the reasons presented above.

**Rejection of Claims 5-7, 9 and 10**  
**under 35 U.S.C. §103(a) as Unpatentable**  
**over Ishii in view of Bernardi**

Claims 5-7, 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Bernardi (U.S. 5,546,145).

Ishii was discussed earlier.

Bernardi discloses apparatus and methods for recording or storing voiced-in messages in message memory associated with an exposed image frame for reproduction as an annotation with prints made from the exposed image frames (see Abstract). The camera user may select a sound recording mode via a user input selector switch 22 (see col. 10, lines 47-48).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Ishii in view of Bernardi fails to teach or suggest all of the claim limitations present in independent claims 1 and 8, as amended, so a *prima facie* case of obviousness has not been established.

For example, regarding independent claim 1, as amended, neither reference discloses storing the captured image and the text as a single digital data file in the memory.

Regarding independent claim 8, as amended, neither reference discloses storing the captured image file and the digital text file as a single composite digital data file in the memory.

For the above reasons, all claims dependent upon independent claims 1 and 8, including dependent claims 5-7, 9, and 10, should be found to be allowable over any combination of Ishii and Bernardi, and Applicant respectfully requests that the rejection of claims 5-7, 9, and 10 under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Bernardi should be withdrawn.

**Rejection of Claims 12-15**  
**under 35 U.S.C. §103(a) as Unpatentable**  
**over Ishii in view of Bernardi**

Claims 12-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Bernardi.

Regarding independent claim 12, as amended, neither reference discloses storing the text data and the digital image data as a composite digital file in a memory of the camera.

Thus, independent claim 12 should be found to be allowable over any combination of Ishii and Bernardi, and Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Bernardi should be withdrawn.

Claims 13 and 14 have been canceled, as mentioned earlier.

Regarding independent claim 15, as amended, neither reference discloses combining the digital image data and the text data into a single digital data file, or storing the single digital data file in a memory of the camera.

Thus, independent claim 15 should be found to be allowable over any combination of Ishii and Bernardi, and Applicant respectfully requests that the rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Bernardi should be withdrawn.

**Rejection of Claim 16**  
**under 35 U.S.C. §103(a) as Unpatentable**  
**over Ishii in view of Shipp**

Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Shipp (U.S. 6,031,526).

Ishii was discussed previously.

Shipp discloses a system for generating electronic and printed medical records that provides automatic integration of captured video still images and voice-dictated information concerning the image (see Abstract).

Regarding independent claim 16, as amended, Ishii fails to disclose an external processor coupled to the camera, which processor is to convert input provided by the camera into text and to combine the text and an image provided by the camera into a common data file. Shipp fails to disclose a camera having a microphone, a memory, and a photo-sensitive array to capture an image.

Applicant respectfully asserts that a *prima facie* case of obviousness has not been established, and that the suggested combination of Ishii and Shipp is based upon hindsight and would not have been suggested but for Applicant's own disclosure.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine them to arrive at Applicant's claimed subject matter. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP §2143.

Applicant respectfully asserts there is no suggestion or motivation in either Ishii or Shipp, whether considered individually or collectively, for combining these two references to arrive at the subject matter claimed in claim 16.

The camera in Ishii is a single-lens reflex camera (col. 3, line 41) which is typically a portable, hand-carried camera. For this reason, there appears to be no motivation or teaching in Ishii for providing an external processor.

The Shipp medical records system is a large, complex, non-portable system (FIG. 1) that does not appear intended to be used as a portable unit. There appears to be no motivation or

teaching in Shipp for combining a microphone 18, A/D 19, and voice-recognition module 20 (see FIG. 1 of Shipp) with a portable, hand-carried camera, such as that disclosed in Ishii.

Thus, Applicant respectfully asserts that a *prima facie* case of obviousness has not been established. First, the Examiner has not provided any suggestion or motivation in the references themselves. Secondly, the Examiner has not provided any credible suggestion or motivation in the knowledge generally available to one of ordinary skill in the art, to combine the Ishii and Shipp references to arrive at Applicant's claimed subject matter.

Thus, independent claim 16 should be found to be allowable over any combination of Ishii and Shipp, and Applicant respectfully requests that the rejection of claim 16 under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Shipp should be withdrawn.

**Rejection of Claims 17-19**  
**under 35 U.S.C. §103(a) as Unpatentable**  
**over Ishii in view of Shipp and Bernardi**

Claims 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Shipp and Bernardi.

For the reasons presented immediately above, Applicant asserts that independent claim 16 is patentable over any combination of Ishii and Shipp. The Examiner asserts that the combination of Ishii and Shipp, further in view of Bernardi, which discloses a user input selector switch 22 (see col. 10, lines 47-48), would render dependent claims 17-19 unpatentable.

However, Applicant respectfully asserts that a *prima facie* case of obviousness has not been established. First, the Examiner has not provided any suggestion or motivation in the Ishii, Shipp, or Bernardi references themselves. Secondly, the Examiner has not provided any credible suggestion or motivation in the knowledge generally available to one of ordinary skill in the art, to combine the Ishii, Shipp, and Bernardi references to arrive at Applicant's claimed subject matter.

Thus, independent claim 16 should be found to be allowable over any combination of Ishii, Shipp, and Bernardi. Further, claims 17-19, which are directly or indirectly dependent upon independent claim 16, should be allowable over any combination of Ishii, Shipp, and Bernardi.

Thus, Applicant respectfully requests that the rejection of claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Shipp and further in view of Bernardi should be withdrawn.

**Rejection of Claim 20**  
**under 35 U.S.C. §103(a) as Unpatentable**  
**over Ishii in view of Shipp**

Independent claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Shipp.

As stated earlier, to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim.

The asserted combination of Ishii in view of Shipp fails to teach or suggest all of the claim limitations present in independent claim 20, as amended, so a *prima facie* case of obviousness has not been established. For example, neither reference discloses storing an audio file and digital image data as separate digital data files in a memory of a portable camera.

For the above reasons, independent claim 20 should be found to be allowable over any combination of Ishii and Shipp, and Applicant respectfully requests that the rejection of claim 20 under 35 U.S.C. §103(a) as being unpatentable over Ishii in view of Shipp should be withdrawn.

**Allowability of New Claims 21-23**

New dependent claim 21 is dependent upon claim 12 and recites that the method further comprises additionally storing the text data as a separate digital file in the memory. Claim 12 should be allowable for the reasons presented earlier, and thus new dependent claim 21 should likewise be allowable.

New dependent claim 22 is dependent upon claim 15 and recites that the method further comprises additionally storing the text data as a separate digital data file in the memory. Claim 15 should be allowable for the reasons presented earlier, and thus new dependent claim 22 should likewise be allowable.



New dependent claim 23 is dependent upon claim 20 and recites that the audio file is stored as a compressed audio file in the memory. Claim 20 should be allowable for the reasons presented earlier, and thus new dependent claim 23 should likewise be allowable.

### Additional Elements and Limitations

Applicant considers additional elements and limitations of claims 1-3, 5-12, and 15-23 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

### Conclusion

Applicant respectfully submits that claims 1-3, 5-12, and 15-23 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Oct. 20, 2003

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of October, 2003.

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